PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of **Joseph HARBAUGH**	Confirmation No.: **4205**
Application No.: **09/826,690**	Examiner: **CASLER, Traci L.**
Filed: **April 5, 2001**	Group Art Unit: **3629**
Attorney Docket No.: **6994-1**	

For: **METHOD FOR ADMITTING AN ADMISSIONS APPLICANT INTO AN ACADEMIC INSTITUTION**

PETITION UNDER 37 C.F.R. §1.182 FOR REMOVAL OF EXAMINER

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
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Applicant respectfully submits that examination of this application has been plagued by Examiner bias, in which the Examiner has issued rejections based on personal opinions rather than substantive references. This timely Petition is accompanied by the $400 petition fee under 37 C.F.R. 1.17(f). Accordingly, by this Petition under 37 C.F.R. 1.182 (hereinafter "Petition"), Applicant respectfully requests substitution of Examiner Casler with an unbiased Examiner in view of Examiner Casler well documented pattern of continued bias as evident from the official Office Actions, including the most recent new examples of bias shown in the Office Action mailed December 7, 2009.

STATEMENT OF FACTS

Since 2001 Applicant has been prosecuting its application through a series of requests for continued examination with many claim amendments aimed at presenting Applicant's invention in a light that the Examiner could understand. Despite many years of different approaches, which included a face to face interview, Applicant does not believe that this application has ever received a fair review by an unbiased examiner who was interested in applying the best art available without distorting that art to meet the Examiner's preconceived notions of what should

be allowable based on the Examiner's very limited experience in the educational field, much of which occurred after the April 5, 2001 filing date of this application.

Applicant's program is unique in the field of law school education and, because of the lack of meaningful references, Applicant believes the claimed program is unique in educational experience generally. Stripped to the bare essentials, Applicant, without admitting a potential student, determines if that student fits into a range that prior law school standardized test scores indicating the student will perform poorly in law school and therefore will not likely be admitted to an accredited law school. Applicant then administers a short course that Applicant has developed solely for the purpose of evaluation followed by a short test as free as possible from any cultural bias. The test hones in on analytical abilities and has been proven to be a good indicator of future success. Applicant has supplemented its application with affidavits of some of the leading legal educators in the country in an effort to have its breakthrough development understood. The program has been successfully licensed to other institutions who use the program to identify students who will be successful in law school despite low test scores. Despite weak rejections that rely heavily on official notice, the Examiner has given little or no weight to these expert declarations.

Applicant's idea to provide a short program before admission takes on added significance where administered, as Applicant claims, over the internet. Take for example an economically disadvantaged young person in a remote area of the country who has no affordable way to show his or her ability to be a successful law school student. He or she can take Applicants' course and test over the internet without leaving home and know whether he or she is likely to be a successful law school student notwithstanding admission criteria that indicate otherwise, *e.g.*, mediocre or worse performance on the standardized Law School Admission Test (LSAT) Examination. Aside from Applicant's proven method, there is no comparable avenue open to law school candidates with subpar academic credentials, *e.g.*, LSAT scores and undergraduate GPAs.

Unfortunately, from the beginning, the Examiner responsible for this case has insisted on reading her limited experience in the education field into an area where she has no experience to

"fill in the gaps" where the references clearly fall short. All that the Applicant asks is that the cited references be applied according to time honored patent examination procedures. Once that happens, then Applicant can be satisfied that the process has been fair and, if differences of opinion still remain, they can be dealt with through the standard examination protocol. It is noted that the inventor is a widely acclaimed former Dean of a law school who has been a legal educator for many years.

The following are examples of the bias that Applicant has had to contend with:

Office Action Mailed April 25, 2005

In the Office Action mailed April 25, 2005, the Examiner insisted that "there must be admission before the student can take courses".[1] In her limited world that was probably true, but not with Applicant's new approach which is all the more reason the Examiner should have tried to understand the impact of Applicant's new direction. Applicant gives a course before admission purely for the purpose of evaluation.

In the same Office Action, the Examiner insisted on hypothesizing about second chances and failures of standardized tests as if these removed any value from Applicants' development.[2] The Examiner asserts that the undisclosed "facts" she needs to rely on for official notice "were taking place long before the examiner was in the field in 1999."[3] Despite this assertion, and Applicant's request to provide evidence supporting the assertions of official notice under MPEP 2144.03, the Examiner has failed to identify a single new reference in any of the six Office Actions that issued after she began taking official notice in this Office Action.

In addition, the Examiner was critical of Applicants' success with respect to the admission of minorities stating that this was not supported by the Applicants' disclosure.[4] As a secondary consideration which goes to the effect of Applicant's invention and not the invention itself, there is no requirement of disclosure of benefit to minorities in the application. This is a benefit of the invention that deserve fair, unbiased consideration.

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[1] Office Action mailed April 25, 2001, Paragraph 50.
[2] *Id.*
[3] *Id.*
[4] *Id.* at Paragraph 53.

Office Action Mailed November 4, 2005

In the Office Action mailed November 4, 2005, the Examiner began what became a continuing theme of taking "official notice" based on her experiences without meaningful citations.[5] "The Examiner draws on her experience as an admissions counselor from August 1999 to ***May 2004*** ... [that targeted enrollment]," which is not what Applicant is claiming, was known. In fact, Applicant claims the converse, by identifying those test takers who are not able to get a fair consideration because of deficient test scores and an overly standardized approach utilized by law schools. Furthermore, it should be noted that this application was filed April 5, 2001, so only one and a half years of the Examiner's five years of experiences could possibly serve as prior art against this application. Applicants respectfully submit that, even if no bias were intended, it would be impossible for the Examiner to draw from only those experiences occurring prior to April 5, 2001.

The Examiner concludes the Office Action by directly contradicting the declaration of Mr. Philip D. Shelton, CEO of the Law School Admission Counsel, based on blanket assertions about what is and is not common in graduate school admissions.[6] As no support is provided for any of the Examiner's assertions, Applicant can only conclude that the Examiner is arrogantly and contemptuously orating on what admission offices do and do not do in order to rebut the declarations of a neutral expert. The Examiner's bias is crystal clear as she was judging the merits of the invention from her perspective rather than applying references to the claims.

Office Action Mailed July 27, 2006

In the Office Action mailed July 27, 2006, the Examiner's lack of respect for both the requirements of patent law and for Applicant's contributions leads the Examiner to sarcastically muse as to why an institution would focus on students who sought admission elsewhere but did not meet the standardized test standards.[7] Apparently, in the Examiner's view, there is limited

[5] Office Action mailed November 4, 2005, Paragraph 12.
[6] *Id.* at Paragraphs 38 and 39.
[7] Office Action mailed November 4, 2005, Paragraph 30.

value in helping groups, such as minorities, who underperform on standardized tests obtain fair consideration for acceptance to graduate school.

In the Office Action, the Examiner shows further evidence of how hampered she is by her preconceived notions and bias against the claimed invention.[8] First, the Examiner places the burden on Applicant to prove that his results are better than the best. Applicant is only interested in producing good lawyers or law students, not the absolute best lawyers or law students in America. Next, the Examiner finds that there is no evidence that if a person knew of the cited references they couldn't develop the solution. Applicant need only note that no one else has ever done it before and that Dr. Philip D. Shelton's declaration expressly says that the developer of the LSAT, the best standardized test in the industry, has conducted extensive research to identify "diamonds in the rough, *i.e.*, students who will be successful despite low test scores,[9] and believes Applicant's method is unrivaled at identifying "diamonds in the rough"![10] Finally, the Examiner attempts to turn "enrolled" in to a term of art to meet her experience. All of this is clearly improper and demonstrates bias.

Office Action Mailed August 23, 2007

In the Office Action mailed August 23, 2007, the Examiner went so far as to submit a declaration about her experiences as an admissions officer at Lake Superior State University and then at Northern Michigan University from August 1999 to May 2004.[11] The Office Action included an obviousness rejection based solely on Examiner Casler's experiences.[12] In addition, to this being completely against Patent Examination procedures,[13] Examiner Casler's Declaration clearly used information occurring after the April 5, 2001 filing date of the instant application. For example, paragraph 5 of Examiner Casler's Declaration deal with experiences and events that took place between Summer 2002 and Fall 2004.[14] This demonstrates how far beyond

[8] Id. at Paragraphs 30, 31 and 32.
[9] Affidavit of Philip D. Shelton, Paragraph 4.
[10] *Id.* at Paragraph 6.
[11] Declaration of Traci L. Casler, Paragraph 2.
[12] Office Action mailed August 23, 2007, Paragraphs 6-7.
[13] MPEP 2144.03.
[14] Declaration of Traci L. Casler, Paragraph 5.

proper examination procedures Examiner Casler's bias has taken her despite the lack of references disclosing the claimed features.

Office Action Mailed March 8, 2008

In the Office Action mailed March 8, 2008, the Examiner again draws on her experience from August 1999 to 2004 to pontificate on what is not novel in law schools, struggles with the non credit approach although it is for evaluation purposes and then lectures applicant not to ignore the MPEP when she relies extensively on her own unsupported, biased opinions throughout the Office Action. [15]

The Examiner continues to essentially regurgitate her remarks even when they do not apply to Applicant's amended claims. The Examiner also continues to take official notice to contradict expert declarations submitted on behalf of Applicant. These instances are particularly egregious because the Examiner provides no support for the taking of official notice despite the fact Applicant challenges the Examiner's taking of official notice and requests documentary evidence supporting the Examiner's position as required under MPEP 2144.03.A., C. and E. Despite these circumstances, the Examiner likens Applicant's program to not being different from any admissions program and she downplays any cultural diversity because it is not claimed. Apparently, the Examiner's bias prevents her from seeing the substantial weakness in the rejection she continues to maintain and from appreciating that a benefit can be achieved while the invention itself is much broader than helping any one class of people.

Office Action Mailed December 7, 2009

In the Office Action mailed December 7, 2009, the Examiner has modified her rejection based on Arenson and www.gradcollege.com to specifically acknowledge it is based upon Official Notice.[16] In this Office Action, the Examiner systematically fails to look at the invention as a whole and uses her personal opinions to contradict sworn statements made by prominent experts in the field to conclude that the claimed method is obvious. For example, in the most recent Office Action, the Examiner attempts to use Official Notice based on her limited

[15] Office Action Mailed March 8, 2008, Paragraphs 9, 10 and 11.
[16] Office Action mailed December 7, 2009, Paragraph 6.

experiences as an admissions officer from August 1999 to May 2004 to rebut the sworn statements of Dr. Philip D. Shelton, the CEO of the LSAT.[17] Dr. Shelton stated that other law schools do not conduct searches for credentials that fall below the law school's admissions standard. The Examiner uses official notice to assert that the existence of a college board database supports her position that any search would be obvious.[18] However, after nine office actions more than five years, the Examiner's position still fails to consider that, as Dr. Shelton explained, (1) ***schools search for acceptable candidates, not unacceptable candidates***, and (2) ***that prior to the claimed method schools have been unable to determine which student with unacceptable academic credentials will perform well once admitted to the school***. Thus, contrary to the Examiner's newest assertions based on official notice, a search for students with sub-standard standardized test scores is not obvious and Dr. Shelton's statements confirm this.

Furthermore, in addition to ignoring certain limitations using official notice, the Examiner also attempts to read complete limitation out of the claims. For example, the Examiner ignores the "academic success" limitation by asserting "a score deemed to correlate with academic success at the school" can be any score, including a failing score. Clearly, this assertion cannot be reconciled with the plain meaning of the term "academic success" or the use of the term in the specification. This is yet another new example, where bias has caused the Examiner to diverge from the applicable standards of patent law in order to form a rejection that supports her preconceived position in the absence of appropriate prior art.

As yet another example of reading limitations out of the claims, the Examiner asserts that referring to "a graduate school" rather than "the graduate school" render the limitations with reference to "a graduate school" meaningless.[19] The Examiner knows full well that the reference to "a graduate school" is the first reference to the phrase in the body of the claims and, therefore, must recite "a graduate school" in order to comply with 35 U.C.S. 112, second paragraph. In addition, subsequent references to graduate school in the claims recite "the graduate school." Clearly, the Examiner is going out of her way, and ignoring the applicable patent law, in order to

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[17] *Id.*, at Paragraph 9. Affidavit of Philip D. Shelton, Paragraph 4 & 6. Stating that the LSAT is the best standardized test in the industry and after conducting extensive research to identify "diamonds in the rough, *i.e.*, students who will be successful despite low test scores, Dr. Shelton believes Applicant's method is unrivaled at identifying "diamonds in the rough."

[18] Office Action mailed December 7, 2009, Paragraph 9, relying on www.collegeboard.com.

[19] *Id.*, at Paragraph 29.

read limitations out of the claims. These actions, which are clear on this record, unequivocally demonstrate bias or the appearance of bias and mandate removal of this Examiner.

POINTS TO BE REVIEWED

A.) Does the examiner's behavior show a pattern of bias?

Throughout the many years of prosecution the Examiner has repeatedly referred to her experience as a College Assistant Administrator. Such a position has no relevance whatsoever to proper examination of Applicant's claimed invention. Yet one can clearly see the Examiner considers her position was of great relevance to patentability. Why else mention it, much less rely on it as a constant source of unsupported official notice? Her experience should make it that much easier to identify highly relevant references, which the Examiner has failed to do. Thus, the Examiner's belief that her experience is so important and her failure to identify highly relevant references demonstrates the bias Applicant has had to deal with.

The Examiner's examination is controlled by this experience which can only teach away from Applicant's new direction. Saddled with her own preconceived bias and position of self-importance, the Examiner can't possibly be acting objectively, particularly, where the majority of her experience occurred after Applicant's filing date.

What gives the Examiner the qualification to submit her own declaration as sole support for an anticipation rejection? Apparently, in the Examiner's mind it is her four years as an assistant administrator. What is even more striking is that despite the Examiner's knowledge regarding admissions administration, the Examiner has been unable to find any quality references to cite against the claimed method. This is clear evidence of bias.

The beauty of Applicant's approach is that it is so non-traditional in terms of what schools of higher education have been doing for so many years. Applicant has provided nine major instances of bias (more if you consider multiple instances within some of the rejections). It seems evident to Applicant's representatives that this bias greatly interfered with the Examiner's ability to properly present 102 rejections (unheard of to support a 102 rejection

solely with the Examiner's own declaration) and 103 rejections where the Examiner has attempted to fill in the gaps with her idea of official notice.

This bias becomes even more evident in later years where she substitutes her opinions, disguised in the form of unsupported Official Notice and personal declarations, to refute statements by no fewer than three prominent experts in the field of graduate school admissions, including two law school deans and the then-CEO of the Law School Admission Counsel. Unsupported or poorly supported official notice simply has no place refuting sworn statements by such prominent experts.

B.) Is there a clear lack of objectivity?

Not only is there the strong evidence of bias as presented above, but there is a direct link to her actions in rejecting claims on references which fail to establish a *prima facie* case of obviousness even the most strained interpretations.

For example, in her citation of www.gradcollege.swt.edu (hereafter "Grad College") she clearly states that the practice of this reference is to conditionally admit students. This is done every day in many institutions. Applicant's claimed method proceeds contrary to this direction because Applicant does not conditionally admit students. The students are evaluated through training and testing before admission and admission is only granted if the student pass the examinations associated with the method. Yet despite this clear difference, the Examiner has asserted this reference and stated that, despite the clear claim language stating otherwise, there must be admission before courses can be taken. This Examiner clearly lacks objectivity.

MEMORANDUM OF LAW

Of particular relevance to the instant facts is *In re Ovshinsky*, 24 1241 (Com'r Pat. & Trademarks 1992), which dealt with a petition to remove an examiner for bias or the appearance of bias. In *In re Ovshinsky*, the issue was framed as whether an examiner should be "removed on grounds of improper conduct, including bias or the appearance of bias." *Id.*, at *15. *In re*

Ovshinsky dealt with a battle of declarations by the Examiners and Applicant over whether the Examiners made derogatory statements about the applicant for patent during an interview between the Examiners and Applicant. *Id.*, at *15. After reviewing all five declarations about the interview, the Commissioner quipped that it was hard to believe that the individuals were all in the same room. *Id.*, at *15. The Commissioner ultimately decided to deny Ovshinsky's petition because the facts asserted by the sides were so contradictory as to completely preclude any reasonable determination of the facts necessary to determine if there was bias or the appearance of bias. *Id.*, at *21.

In contrast to *In re Ovshinsky*, the record at issue clearly demonstrates that Examiner Casler has engaged in bias and her actions produce the appearance of bias. In fact, the Examiner contravened patent examination procedures to issue a rejection based exclusively on her own declaration, which relied heavily on experiences that occurred well after the April 5, 2001 filing date of the application. Furthermore, despite repeated requests by Applicants under MPEP 2144.03, the Examiner has not provided any evidentiary support for her taking of official notice on other points of contention. Finally, the Examiner continues to attempt to fill in glaring deficiencies in the cited art by drawing on her experiences as an admissions officer, despite her clear inability to separate whether the events occurred before or after the filing date and her inability to find evidentiary support despite her contentions that these were used well before 1999. The Examiner's reliance on her own recollection, rather than identifying evidentiary support, despite serious gaps in the *prima facie* case of obviousness shows a complete disregard for the applicable patent law and is clear evidence of bias and the appearance of bias.

ACTION REQUESTED

Applicant is entitled to have its application reviewed by an Examiner who is completely objective and who is free from any bias which is the result of past experiences. This Examiner has demonstrated a clear pattern of bias which has already greatly compromised Applicant's patent rights and business dealings. It is inherently unfair to Applicant to be required to appeal Patent Office determinations, when there has not been a fair review at the Examiner level. Applicant is entitled to have the fair meaning of terms of references applied not as those terms are interpreted by an Examiner intent on making the references fit her preconceived notions.

Respectfully submitted,

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